REMARKS

Claims 30-36 are presently pending in the subject application. Claim 30 is amended herein. In the Office Action dated August 18, 2003, Claims 30, 34 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon (U.S. Patent No. 6,067,561) in view of Bapat et al. (U.S. Patent No. 6,236,996). Claims 31 and 33 were rejected under § 103(a) as being unpatentable over Dillon in view of Bapat and further in view of Arnold (U.S. Patent No. 6,275,848). Claim 32 was rejected under § 103(a) as being unpatentable over Dillon in view of Bapat, in view of Arnold and further in view of Devine et al. (U.S. Patent No. 6,385,644). Claim 36 was rejected under § 103(a) as being unpatentable over Dillon in view of Bapat further in view of Homan et al. (U.S. Patent No. 6,317,485).

Applicant disagrees with these grounds of rejection and wishes to clarify various distinctions of Applicant's invention over the cited art. Reconsideration is therefore requested in light of the following remarks.

Applicant's Teaching in Comparison to the Cited Art

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

Applicant discloses a method and system for securely distributing an electronic message (*i.e.*, electronic communication) the is designated for a plurality of different recipients in an efficient manner using centralized storage and management. In particular, the method involves storing a single copy of the message on server, *only when the message is designated for a plurality of recipients*. Unlike conventional methods, the present method *makes a decision whether the Email is designated for a plurality of recipients*, to determine whether to *store a single copy of the message on the server*. The system does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored. In various embodiments, the system tracks, tests and routes requests from

the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved.

Thus, a single copy of the message can be stored on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the system also stores instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipients' systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally message for any number of reasons (*e.g.*, for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

The cited prior art references, alone or in combination, fail to teach the combination of features of Applicant's embodiments in any manner that would fairly suggest or motivate one of ordinary skill in the art to create a message management system like Applicant's.

Dillon is directed to sending notifications (alerts) of Email messages to recipient's using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art.

Applicant respectfully submits that the Examiner has mischaracterized the teaching of Dillon by reading more into that references than is actually taught therein. In particular, the Examiner stated that "Dillon teaches a computer-implemented method for *one of a plurality of designated recipients* of an Email communication to receive the Email communication from *a server that stores a single copy of the Email communication.*" In-fact, Dillon is totally silent about any aspect of *storing a single copy* of the email communication that is *dependent* on whether the email communication is *designated for a plurality of recipients* or not. The cited text at col 1, line 25 to col 2, line 38 and col. 3 lines 12-65 teaches nothing about how to treat the Email communication that depends on whether a plurality of recipients is designated. Rather, the cited text at most teaches storing a copy of the Email communication on a server and sending a notification of the Email communication to a subscriber.

When taken for what it teaches as a whole, based on what one of ordinary skill in the art knows regarding how Email services conventionally operate, one would at most infer from Dillon, that if a plurality of recipients were designated, the Email communication would be stored in each of the subscribers' directories on the server, *i.e.,* multiple copies of the Email communication would be stored, one for each of the designated plurality of recipients. It is impermissible for the Examiner to read more into Dillon than is actually taught therein. Applicant teaches *storing a single copy of the Email based on whether a plurality of recipients is designated*, not Dillon.

In addition, the cited text at col 1, lines25 to col. 2. kine 38 and col. 3 lines 12-68 does not teach that "the method of Dillon is performed by receiving computer lacking sufficient permanent storage to store the Email communication" as stated by the Examiner. The cited .text refers generally to local area networks, the Internet, and paging notification systems and makes no reference to implementing the method particularly for receiving computers lacking sufficient memory for permanent storage.

Accordingly, Dillon fails to teach important elements taught by Applicant.

Applicant also respectfully submits that the Examiner has mischaracterized the teaching of Bapat. The Examiner stated that Bapat teaches "receiving from the server a copy of the requested Email communication (e.g. col. 14, lines 34-64)." In fact, the cited text teaches nothing about handling Email communications whatsoever. Bapat as a whole is directed toward an access control database that has access control objects that collectively stores information that specifies access rights by user to specified sets of the managed objects in the database (see Abstract and Summary at col 3, lines 15-45). The cited text discloses using objects to define access rights to a set of managed objects (described at col. 14, lines 34-42). This is accomplished using an event registry, which is a software module that maintains a table of user event requests (described at col 14, lines 43-64). The term "Email" or the equivalent concept, in-fact, does not appear anywhere in Bapat. Therefore, Bapat fails to teach or suggest anything about receiving from the server a copy of the requested Email communication as taught by Applicant.

Moreover, the motivation provided by the Examiner to combine Dillon and Bapat is "because it would be more convenient for a user to have a local copy of an Email in case the user is off line and wants to modify the local copy of the email, the user could without modifying the original Email that could be used as an archived document for reference if desired." While this is certainly one of the advantages of Applicants embodiments, it is equally certain that neither Dillon nor Bapat teach the desirability of having such a method that provides such an advantage nor a system to accomplish the same. The Examiner has not shown, and Applicant cannot find, where Dillon or Bapat would motivate one of ordinary skill in the art to provide such a method or system to accomplish the stated advantages. Even if the cited art taught what the Examiner said it taught, (which it does not) it would still be impermissible hindsight for the Examiner to take the advantages provided from Applicant's teaching to supply the motivation to combine the elements taught in the prior art. The prior art references themselves must provide the requisite motivation.

Applicant further submits that the Examiner has not properly characterized Arnold, which was said to teach "when access to the Email communication is no longer desired, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email." What Arnold teaches at the cited passages and elsewhere, is

detaching attachments from Email messages based on size (or other criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. The cited text does not refer to deleting the email message per se, but to deleting the attachment that has been detached from the original Email message. Arnold thus has three components, the first (original) Email, a detached attachment from the Email separately stored, and a second Email that includes an address of the stored attachment. The deletion referred to in the cited text is with respect to the stored attachment, not the original Email. Accordingly Arnold also fails to teach elements of Applicants embodiments.

The Claims and Rejections

Rejections under § 103. Turning now to the claims and the rejections thereof, the preamble of base claim 30 originally recited, "A computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email communication from a server that stores a single copy of the Email communication, the method comprising..." Applicants submit that that this language in the preamble sets forth required elements of Applicants invention The present amendment to base claim 30 recites "A computer-implemented method for *one of a plurality of designated recipients* of an Email communication to receive the Email, comprising, *storing a single copy of the Email communication designated for the plurality of recipients* on a server. This amendment merely moves the originally recited required elements form the preamble to the body of the claim and <u>does not</u> change the scope of the claim necessitating new grounds of consideration based on the amendment.

As discussed above, this type determination of whether or not to store a single copy of the Email message based on whether or not it is designated for a plurality of recipients, as emphasized in the italicized portions above, is not taught or suggested by Dillon or Bapat or the combination of the same. These important elements of the claimed invention are all together absent from the references. Therefore, the combination does not yield the claimed invention. Moreover, the combination of references fails to provide any motivation for using such a method

for handling Email communications. Therefore, Applicant request withdrawal rejection of the base claims 30 on grounds of obviousness over Dillon and Bapat.

Each of the remaining claims 31-36 depend from an allowable base claim and are patentable at least for that reason. Applicant therefore also requests withdrawal of the rejections these claims on grounds of obviousness. –This is not an admission that patentability of any of these dependent claims rises and falls with the independent claims. For example, as mentioned above, Dillon and Arnold fail to teach the elements some of the dependent claims as asserted by the Examiner. However, this expedient is used herein in the interest of brevity. Applicant reserves the right to further distinguish the dependent claims over Dillon, Arnold, Devine and Homan at a later time if necessary.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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